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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,282	03/30/2004	Yasutaka Nakashiba	8008-1052	2273
⁴⁶⁵ YOUNG & THOMPSON 209 Madison Street Suite 500 ALEXANDRIA, VA 22314			<div>EXAMINER</div> <div>JACKSON JR, JEROME</div> <div>ART UNIT</div> <div>PAPER NUMBER</div> <div>2815</div>	
			<div>MAIL DATE</div> <div>01/02/2009</div>	<div>DELIVERY MODE</div> <div>PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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Office Action Summary

Application No.

10/812,282

Applicant(s)

NAKASHIBA, YASUTAKA

Examiner

Jerome Jackson Jr.

Art Unit

2815

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 4 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s) Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s) Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/29/08 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

All claims are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo in view of O and further in view of APA (applicant's prior art admissions), of record.

The previous rejection still applies. The new limitations and claims do not distinguish over the applied art of record because Kudo discloses different thickness gate insulation layers to suit the power or threshold requirements of the transistors, or other circuit requirements. There is nothing novel in applicant's recitations of multiple MOS transistors having either similar gate oxide thicknesses or different gate oxide thicknesses because Kudo and O disclose gate oxide thicknesses are chosen and varied for particular circuit, power or threshold requirements, and further, varactors of thinner oxide thicknesses than MOS transistors are also disclosed. The applied art, O, clearly discloses thinner oxide thickness for varactors vis-avis thicker oxide transistors. There are multiple MOS transistors in Kudo with same thicknesses and other multiples of MOS transistors with different thicknesses. Thus neither independent claim

distinguishes over the applied art. The additional dependent claims also do not distinguish over the applied art for the reasons of record.

Applicant's arguments filed 9/29/08 have been fully considered but they are not persuasive. Applicant's argument the thickness of the varactor oxide is the same as the thinnest transistor gate oxide of the prior art, is not convincing of patentability. Kudo discloses at least three oxide thicknesses for three different groups of MOS transistors. The varactor oxide thickness is the same as the thinnest MOS oxide. All the thinnest oxide devices can be labeled "varactor". The two other groups of transistors with thicker gate oxides can be labeled MOS transistors. Accordingly, claim 23 is rejected. Claim 36 is rejected as well because the thickest transistors of Kudo are MOS transistors and there are multiple numbers of these similar "thickest" MOS transistors. Likewise there are "varactors" of the thinnest oxide structure. The claims are still too broad to distinguish over the art of record. Applicant is reading too much structure into the labeling of the thinnest (or thickest) of the MOS structures. Any of the MOS structures can be labeled as a transistor or varactor. Mere labeling will not distinguish these claims over the applied art.

>While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. >*In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); <*In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

See also In re Swinehart 169 USPQ 226, Ex parte Minks 169 USPQ 120 and In re Pearson 181 USPQ 641 where it was decided that functional language, statements of intended use, or mere labels do not structurally distinguish claims over anticipating prior art.

The new claim recitations "about" also do not distinguish over the applied art having similar "about" dimensions, as the prior art transistors and varactors are of similar dimension. Note one of skill would determine exact dimensions according to routine design. There are no unexpected results here.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Jackson Jr. whose telephone number is 571-272-1730. The examiner can normally be reached on M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Parker can be reached on 571-272-2298. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jerome Jackson Jr./
Primary Examiner, Art Unit 2815